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REMARKS

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are non-enabling under 35 U.S.C. § 112, first paragraph, is directed to non-statutory subject matter under the provisions of 35 U.S.C. §101 or made obvious under the provisions of 35 U.S.C. §103. Thus, the Applicants believe that all of these claims are now in allowable form.

I. REJECTION OF CLAIMS 1, 3-20 AND 22-40 UNDER 35 U.S.C. § 112

The Examiner has rejected claims 1, 3-20 and 22-40 under 35 U.S.C. § 112, first paragraph for allegedly failing to comply with the enablement requirement. In response, the Applicants have amended independent claims 1, 20, 39 and 40, from which claims 3-19 and 22-38 depend, in order to more clearly recite aspects of the invention.

In particular, the Examiner submits that "the claim language 'associating the supporting evidence [with] said answers and generating a new argument having an associated conclusion based on such answers and supporting evidence' can be interpreted to mean that a user request[s] the supporting evidence and then makes a determination as to which argument to pursue next based on the supporting evidence and the answer to the previous question" (See, page 3 of the Office Action).

The Applicants have amended the claim language to clarify that the user provides answers and supporting evidence in response to template questions, and that the analytical system then generates an argument based on the provided answers, where the argument supports a conclusion. The system further publishes (*i.e.*, stores) the argument, including the answers, the supporting evidence and the conclusion for review (*e.g.*, by other users in a collaborative environment or by a user looking to see if an argument regarding a similar situation was generated in the past).

Moreover, the Examiner submits that "even if the computer somehow takes the associated evidence and generates a new argument ... this is not described in the specification in such a way as to enable one of ordinary skill to make or use the invention". The Applicants respectfully disagree. For example, the limitations of receiving supporting evidence and associating the supporting evidence with answers

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are described at least in paragraphs [0032], [0049], [0053], [0062], [0063], [0073] and [0074] of the Applicants' published application ("The user may at least partially complete the instantiated argument by answering one or more questions of the instantiated argument and associating rationale statements and supporting relevant evidence with each answered question"; "The user may also associate exhibits with one or more questions that may be relevant to answering such question so that other collaborative users may answer the question using the associated exhibit ...", paragraph [0032], emphasis added). The limitation of publishing an argument is described at least in paragraphs [0033], [0034], [0048], [0049] and [0079] ("The historical arguments/templates include arguments and templates that have been completed and stored within memory (also referred to as 'published' arguments"; "After the argument or template is generated ... the finished arguments and templates are then stored in memory as historical arguments and templates", paragraph [0033], emphasis added).

Therefore, the Applicants submit that independent claims 1, 20, 39 and 40, as amended, fully satisfy the requirements of 35 U.S.C. §112. Dependent claims 3-19 and 22-38 depend from claims 1 and 20 and recite additional features therefore. As such, and for at least the reasons set forth above, the Applicants submit that claims 3-19 and 22-38 also fully satisfy the requirements of 35 U.S.C. §112. Accordingly, the Applicants respectfully request that the rejection of claims 1, 3-20 and 22-40 under 35 U.S.C. §112 be withdrawn.

II. REJECTION OF CLAIMS 1, 3-20 AND 22-40 UNDER 35 U.S.C. § 101

The Examiner has rejected claims 1, 3-20 and 22-40 under 35 U.S.C. §101 as being allegedly unsupported by either a specific and substantial asserted utility or a well established utility. In response, the Applicants have amended independent claims 1, 20, 39 and 40, from which claims 3-19 and 22-38 depend, in order to more clearly recite aspects of the invention.

In particular the Examiner submits that "the claim language 'associating supporting evidence [with] said answers and generating a new argument having an associated conclusion based on such answers and supporting evidence' can be

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interpreted to mean that the computer somehow takes the associated evidence and generates a new argument". The Examiner further submits that "this is not described in the specification in such a way as to enable one of ordinary skill to make or use the invention" (See, page 4 of the Office Action).

As discussed above, the Applicants have amended the claim language to clarify that the user provides answers and supporting evidence in response to template questions, and that the analytical system then generates an argument based on the provided answers, where the argument supports a conclusion. The system further publishes (*i.e.*, stores) the argument, including the answers, the supporting evidence and the conclusion for review (*e.g.*, by other users in a collaborative environment or by a user looking to see if an argument regarding a similar situation was generated in the past). As also discussed above, such limitations are described in several places in the specification.

In light of the amendment, the Applicants submit that independent claims 1, 20, 39 and 40, and claims 3-19 and 22-38 that depend therefrom, fully satisfy the requirements of 35 U.S.C. §101. Accordingly, the Applicants respectfully request that the rejection of claims 1, 3-20 and 22-40 under 35 U.S.C. §101 be withdrawn.

III. REJECTION OF CLAIMS 1, 3-20 AND 22-40 UNDER 35 U.S.C. § 103

A. Claims 1, 3-14, 17-20, 22-33 and 36-40

The Examiner has rejected claims 1, 3-14, 17-20, 22-33 and 36-40 under 35 U.S.C. §102(e) as being unpatentable over the Calver application (United States Patent Application Publication No. 2001/0032092, issued on October 18, 2001, hereinafter "Calver") in view of the Janssen patent (United States Patent No. 6,098,062, issued August 1, 2000, hereinafter "Janssen"). The Applicants respectfully traverse the rejection.

Particularly, the Applicants submit that the teachings of Calver and Janssen provide no motivation for their combination to support the rejection under 35 U.S.C. §103. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of

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persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

Calver addresses a problem of engaging small businesses in electronic commerce (e.g., over the Internet). To this end, Calver teaches a web-based portal that matches a user to products or services based on his or her answers to a series of questions. That is, the user answers a series of questions, and, based on the user's answers to the questions, the system retrieves information on the products or services in which the user will likely be interested.

Janssen addresses a problem of documenting explicit grounds for hypotheses or claims in a decision making process. To this end, Janssen teaches a system in which a user presents a hypothesis, possibly along with some sort of "backing" for the hypothesis. Other users are then encouraged review the presented hypothesis and to provide their own backing to support either the hypothesis or a counter hypothesis. As discussed above, Calver addresses a problem of a different nature – providing user-tailored product and service information to small businesses. Calver also fails to teach or suggest anything relating to the building of arguments, e.g., to support conclusions relating to a given situation. In fact, the words "argument" and "conclusion" do not even appear in Calver's disclosure. Nor does Calver teach or suggest anything related to the art of decision making that could hint toward a combination with Janssen.

In fact, the teachings of Calver actually teach away from a combination with Janssen. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). While Calver works toward a conclusion (e.g., appropriate product and service information) by asking a user to answer a series of questions, Janssen actually works from the conclusion (e.g., a hypothesis) by asking a user to provide an explanation or backing for the conclusion (or a counter conclusion). Thus, modifying the web-based portal of Calver to work from a predefined conclusion, as taught by Janssen, would necessarily change the principle of operation of Calver, which cannot select products or services that meet a user's interests or needs before those interests or needs are determined (i.e., through a series of questions). Likewise, modifying the system of

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Janssen to ask a series of questions before generating a conclusion, as taught by Calver, would necessarily change the principle of operation of Janssen, which solicits information from users that either proves or disproves an already given hypothesis.

Finally, the Examiner has not put forth any objective evidence that one of ordinary skill in the art of decision making would have knowledge of the art of electronic commerce. Thus, the Applicants respectfully submit that the Examiner is using hindsight to pick and choose elements from the references to support the rejection, by locating a reference based on an aspect of the Applicants' *solution* to the problem (providing supporting evidence for an answer to a template question) rather than the *problem* that was being addressed. It is impermissible to use the claims as a framework from which to choose among individual references to recreate the claimed invention. *W.L. Gore Associates, Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312 (1983).

The Examiner concedes that Calver fails to teach, show or suggest every limitation of the Applicants' claimed invention. Moreover, as discussed above, there is no motivation for the proposed combination of Calver with Janssen, a reference that actually teaches away from combination with Calver. Therefore, the Applicants submit that for at least the reasons set forth above, independent claims 1, 20, 39 and 40 fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Dependent claims 3-14, 17-19, 22-33 and 36-38 depend from claims 1 and 20 and recite additional features therefore. As such, and for at least the reasons set forth above, the Applicants submit that claims 3-14, 17-19, 22-33 and 36-38 are not made obvious by the teachings of Calver in view of Janssen. Therefore, the Applicants submit that dependent claims 3-14, 17-19, 22-33 and 36-38 also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

B. Claims 15-16 and 34-35

The Examiner has rejected claims 15-16 and 34-35 under 35 U.S.C. §102(e) as being unpatentable over Calver in view of Janssen and further in view of the Grosser et al. patent (United States Patent No. 6,826,552, issued November 30, 2004, hereinafter "Grosser"). The Applicants respectfully traverse the rejection.

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As discussed above, the teachings of Calver and Janssen provide no motivation for their combination to support the rejection under 35 U.S.C. §103. Grosser fails to bridge this gap in the teachings of Calver and Janssen. Therefore, the Applicants submit that for at least the reasons set forth above, independent claims 1 and 20 fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Dependent claims 15-16 and 34-35 depend from claims 1 and 20 and recite additional features therefore. As such, and for at least the reasons set forth above, the Applicants submit that claims 15-16 and 34-35 are not made obvious by the teachings of Calver in view of Janssen and further in view of Grosser. Therefore, the Applicants submit that dependent claims 15-16 and 34-35 also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.


IV. CONCLUSION

Thus, the Applicants submit that all of these claims now fully satisfy the requirements of 35 U.S.C. §112, 35 U.S.C. §101 and 35 U.S.C. §103. Consequently, the Applicants believe that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring the issuance of a final action in any of the claims now pending in the application, it is requested that the Examiner telephone Mr. Kin-Wah Tong, Esq. at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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Date


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